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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,840	01/12/2000	Michael Robert Hanson	04860.P1712C	6190

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02/24/2004

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EXAMINER

HONG, STEPHEN S

ART UNIT PAPER NUMBER

2178

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/481,840

Applicant(s)

HANSON ET AL.

Examiner

Stephen S. Hong

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/15/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 16-25, 28, 30-35, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 16-25, 28, 30-35, and 38-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to the Request for Continued Examination and Amendment filed on December 15, 2003.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 14, 16-25, 28, 30-35, and 38-39 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan et al (5,745,113) in view of Adobe PageMill version 2.0 and Simpson, Mastering WordPerfect 5.1&5.2 for Windows™, SYBEX Inc., 1993, pp. 993-1003.

With respect to independent claims 14, 20, and 31, and dependent claims 17-18, 21-22, 25, 28, 30, 32, 35, and 38-39, Jordan discloses a user interface which allows a user to edit, manipulate, and define objects to create new ones. Refer to Jordan's abstract, figures 2 and 3, and column 6 (line 15) through column 8 (line 7). Jordan discloses a map editor, which allows a user to create a map. Specifically, at column 6 (lines 30 et seq—with reference to figure 2), Jordan discloses, *To add to a map, a user will select an object type from a palette of objects 30 and place it in the map drawing pane 32, creating an instance of the object type. There the object can be positioned, resized, duplicated, grouped with other objects to form larger objects, aligned with another object[ed], deleted, and so on.* At column 6 (lines 40 et seq), Jordan further discloses, *The map editor has a number of predefined types of objects that might be found in typical office settings . . . The objects appear in palettes, a limited number of which may be selected by the user to appear on the map editor window. A user may create new objects and palettes at any time.* At column 7 (lines 19 et seq—with reference to figure 3), Jordan discloses, *an object editor, invocable as a menu item, allows a user to create new types of display objects (user-defined map object types) or modify existing ones. Through dialog boxes, the user selects an existing or new object, edits how it is displayed on a map, edits the icon used for it on palette buttons, specifies the types of record in the database that objects of the type can point to, renames it, or removes it.*

Thus, Jordan teaches a “palette window” at figure 2 (left side) and figure 3 (left side), which comprises a “list” that includes “predefined objects” (top left) and “user-

defined objects"—*A user may create new objects and palettes at any time* (column 7). Jordan discloses a "view window" at the right side of both of figures 2 and 3. An "input device" (mouse or keyboard—see figure 1) is used to select and manipulate objects. Jordan also discloses a *PALETTE SET POP-UP* in figure 2, which includes an arrow that evidently provides more selections than the illustrated *Basic Set*. It is noted that the claims do not require that the first and second lists be displayed simultaneously. It is noted that Jordan fails to teach "HTML objects". However, Adobe discloses a web page development application that includes the use of "HTML objects". For example, refer to Adobe's page 36 (2nd paragraph): *Adobe PageMill lets you create pages without typing any codes—unlike many other applications for designing Web pages that require you to learn the HTML codes (called tags) that format the text, graphics, and objects on a page*. At page 71, Adobe illustrates a palette window (***Finder Window*** and ***Pasteboard***); at page 77, Adobe illustrates finding and replacing objects, including *objects such as links or form buttons or controls, text, and so on*. Other examples of "HTML objects" available for the user to include in created web pages abound throughout the Adobe manual such as the HTML Table object on page 116 for inclusion of the table in a web page. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Adobe with Jordan because adding hyperlink functionality to Jordan's invention would enhance the flexibility of the invention by allowing users to derive user-defined objects from the internet while creating or editing the user interface. Furthermore, it was well known to implement user interfaces such as

Jordan's with HTML capability because of the known advantages, including navigational capabilities, of HTML applications.

However, Jordan does not appear to teach the limitation, that the first list of predefined objects and the second list of user-defined objects are displayed simultaneously. Nevertheless, the missing feature is taught by the prior art of Simpson. Simpson teaches a well known document editor called WordPerfect 5.1. In the prior art Simpson teaches that the user can create the user-defined command objects called "Macros" (see pages 993-994). Simpson then teaches the Macros can be added to the palette as a button object (see page 998, "Attaching a macro to a button" section). In the section , Simpson teaches that the user-defined macro objects are added to the menu area after the first list which contains the pre-defined command objects that come with the WordPerfect 5.1. (see FIGURE L9.3, on page 1003, "Trpose" object). Therefore, given the teaching of Simpson, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have modified Jordan to display both the predefined objects and user-defined objects to be displayed simultaneously, since a person of ordinary skill would have appreciated the benefit of accessing the different types of command objects while authoring the document without leaving the current editor screen.

With further regard to dependent claims 16, 23-24, and 33-34, Jordan illustrates "predefined objects" at the top left side of each of figures 2 and 3.

With regard to dependent claim 19, refer to Jordan's figure 5, in which a "list of properties" is illustrated in an "object editor window".

Response to Arguments

4. Applicant's arguments filed 12/15/03 have been fully considered but they are not persuasive.

On page 10 of the argument, Applicant asserts that "the Simpson reference is inapt to the present claimed invention." Applicant follows the argument by pointing out that "the elements taught in Simpson ...are commands that perform some operation on a WordPerfect document... [and such] elements are not objects (HTML or otherwise) that can be added to or included in a web document." Furthermore, Applicant argues that there would be no motivation to combine the references, since, on page 13, "Jordan discloses a map editor that can be used to record and display information about work practices [and in] contrast, Simpson discloses certain features of a word processor."

Firstly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). That is, as pointed out in the rejection, the prior art reference of Jordan is used to show the graphical user interface technique which allows the user-defined objects to be created and displayed in the palettes. The Adobe reference shows creating web pages by selecting the HTML objects in the palettes to be incorporated in the page. The reference of Simpson teaches that the user-defined objects and the pre-defined objects can be displayed in a single palette. Therefore, attacking the Simpson's

reference for not showing the HTML objects to be incorporated in a web page is not persuasive, since Adobe clearly teaches that feature.

In response to applicant's argument that Simpson discloses a word processor and Jordan teaches invention to record and display information about work, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, what is incorporated is the specific Graphical User Interface (GUI) technique, not a brut bodily incorporation.

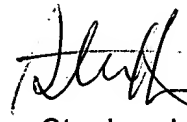
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2178

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Stephen Hong
Primary Examiner
Art Unit 2178
February 23, 2004